

REMARKS/DISCUSSION:

This Response C is being filed within one month after the shortened statutory period for response that ended on February 18, 2010. Accordingly, a Petition for a One-Month Extension of Time is made a part of the electronic filing hereof.

By this Response C, claims 1-14 and 16-20 are pending in this application. Claims 1 and 16 are amended to specifically recite an ultrasonic waveguide and an ultrasonically actuated blade. Support can be found at ¶¶ [0032]-[0037] and Fig. 1.

Amendment and/or cancellation of claims are not to be construed as a dedication to the public of any of the subject matter of the claims previously presented. Further, any amendments or arguments are made without conceding the correctness of any of the rejections of the pending Office Action, and Applicant(s) reserves the right to prosecute the subject matter of such claims in continuation and/or divisional applications.

Applicant has carefully studied the outstanding Office Action. This Amendment is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

A. Rejection under 35 U.S.C. § 102(b)

Claims 1-11 and 16-20 stand rejected as being anticipated by U.S. Patent No. 5,275,607 to Lo as noted in the office action. The examiner states that Lo discloses a housing 22; an outer tube 72 having a proximal end joined to the housing and a distal end; a waveguide 32 positioned within the outer tube and having a vibrating/oscillating asymmetric blade 30 or a blade symmetric in at least one plane positioned at the distal end of the waveguide Fig. 1; and a lumen 38 positioned within the outer tube having an end positioned in an overlapping C9L30-36 relationship with the blade. The lumen is moveable distally or radially C9L37-39 and provides suction or irrigation to a surgical site, see claim 15, C7L L33-43. The blade is designed to vibrate in a longitudinal mode coupled with either a transverse or torsional mode and the lumen is fixed or moveable to a position adjacent to the transverse or torsional node to facilitate suction C5 L40-55. The instrument proximal end has controls for suction and or irrigation C15 L39-46. Office Action of 11/18/2009, page 3.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. In addition, the elements in the prior art reference must be arranged as required by the claim. Lo fails to disclose each and every element arranged as required by the claim.

- i. Lo does not disclose a lumen in an overlapping relationship with an ultrasonically actuated blade*

Independent claims 1 and 16 have been amended to recite:

1. An ultrasonic surgical instrument comprising:
a housing;
an outer tube having a proximal end joined to the housing, and a distal end;
an ultrasonic waveguide positioned within the outer tube, and having
an ultrasonically actuated asymmetric blade positioned at the distal end of the waveguide; and
a lumen positioned within the outer tubing and having an end positioned in an overlapping relationship with the blade.
16. An ultrasonic surgical instrument comprising:
a housing;
an outer tube having a proximal end joined to the housing, and a distal end;
an ultrasonic waveguide positioned within the outer tubing, and having
an ultrasonically actuated blade symmetric in at least one plane positioned at the distal end of the waveguide; and
at least one lumen positioned in within the outer tube and in an overlapping relationship with the blade.

In the first instance Lo does not disclose an ultrasonic waveguide or an ultrasonically actuated blade. Further, claims 1 and 16 define a blade as either asymmetric or symmetric in at least one plane at the *distal end of the waveguide* (*emphasis added*). The examiner mischaracterizes the blade as it is disclosed in Lo. The examiner references 30 as defining a “blade”. That is incorrect. Reference 30 recites a blade member, which includes an elongated portion 30a and a transversely or laterally extending blade 30b. Col. 9, lines 45-47. The lumen 38 (as defined by the examiner) in Lo does not extend in an overlapping relationship with the blade as the blade is defined in claims 1 and 18 or in Lo. At best, using the examiner’s interpretation, lumen 38 is positioned in an overlapping relationship with an elongated portion 30a, of

a blade member 30, but not in an overlapping relationship with a transversely or laterally extending blade 30b.

ii. *Lo does not disclose an ultrasonically actuated blade positioned at the distal end of the waveguide*

In addition, if the examiner defines a waveguide as taught in Lo as element 32¹, then the blade (30b as defined by Lo) is not positioned at the distal end of the waveguide 32. Rather the elongated portion 30a is positioned at the distal end of waveguide 32. Lo teaches a blade 30b at the distal end of the elongated portion 30a, and the blade 30b is distal of the waveguide 32, but the blade 30b is not positioned at the distal end of the waveguide 32 (again, strictly as defined by the examiner).

Claims 2-11 all depend from claim 1 and claims 17-20 depend from claim 16. Without acquiescing in any way to arguments presented by the Examiner as to these claims, Applicant(s) submits that these claims are likewise patentable over Lo for at least the same reasons as discussed above with respect to claim 1 and 16, respectively, by virtue of their dependency from claims 1 and 16. Withdrawal of the rejections as to these claims is likewise requested.

Applicants further note that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness. For example, the examiner states that the lumen 38 provides suction or irrigation to a surgical site (see, claim 15 and col. 7, lines 33-43).

However, neither of the cites provided by the examiner indicate that the lumen 38 is used for irrigation or suction. Rather, col. 7 simply states “a hollow shaft through the solenoid and provided with an attached infusion tube to inject liquid into the eye”.

Claim 15 simply states “a suction tube is connected to the hollow body² and through the surgical tube for vitreous applications”. In both cites, there is no mention of a lumen as it relates to reference 38 as the means for suction or irrigation. In addition, claims 6-8 recite placement of the lumen adjacent a node. Lo neither discloses nor suggests a node or placement of the lumen adjacent a node.

¹ Lo refers to element 32 as a bushing (C9L2), not a waveguide as characterized by the examiner.

² “the hollow body” is indefinite in claim 15.

Rejection under 35 U.S.C. § 103(a)

Claims 12-14 stand rejected as being unpatentable over Lo as noted in the office action. Claims 12-14 depend from claim 1, and based upon the previous discussions, Lo, disclose or suggest the claimed invention. Reconsideration is requested.

Conclusion

Applicant submits that in view of the discussion, the rejections under 35 U.S.C. §§ 102(b) and 103(a) have been overcome and that the invention is now patentable over the cited prior. The Examiner is respectfully requested to reconsider all rejections and pass this case to issue.

Should any minor points remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, which may be required to Account No. 10-0750/END0797USNP/VEK.

Respectfully submitted,

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